



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,783	02/28/2002	Choong-Chin Liew	4231/2002	8718

29933 7590 12/29/2004

PALMER & DODGE, LLP
KATHLEEN M. WILLIAMS
111 HUNTINGTON AVENUE
BOSTON, MA 02199

EXAMINER

LEE, MATTHEW C

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



**UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
---------------------------------	-------------	---	---------------------

EXAMINER

ART UNIT	PAPER
----------	-------

20041221

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The communication filed on October 7, 2004 is not fully responsive to the prior Office action. The applicant has elected and canceled group XVI, claims 36-44. However, claims 36-44 have been canceled. New claims 58-73 drawn to a non-elected group have been filed. Applicant states that the new claims are directed to elected subject matter when in fact the newly presented claims are not readable on the elected invention because the elected group (group XVI, claims 36-44) is drawn to a method of diagnosing osteoarthritis (OA) comprising hybridizing a nucleic acid sample to an array wherein hybridization of the sample to the array is indicative of OA whereas the newly presented claims are drawn to a method of diagnosing OA comprising determining the level of RNA transcripts corresponding to genes selected from Figure 6 and wherein a difference in expression level from normal individual is indicative of OA. The two methods each recite different method steps and have different modes of operation, thus, are considered to be two separate and distinct methods. As it currently stands, there are no elected claims pending. Canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03).

Since the above-mentioned amendment appears to be a bona fide attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C Lee whose telephone number is (571) 272-2931. The examiner can normally be reached on 9am - 5pm, Mon - Fri.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL P WOODWARD can be reached on (571) 272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Matthew C Lee, Ph.D.
Art Unit 1631

December 22, 2004